PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Yves LE GENDRE, et al.

Docket No: Q62357

Appln. No.: 09/739,305

Group Art Unit: 2681

Confirmation No.: 3328

Examiner: Erika A. GARY

Filed: December 19, 2000

For: A METHOD OF OBTAINING INFORMATION ON THE IDENTITY OF A CALLER IN A TERMINAL OF A TELEPHONE COMMUNICATIONS NETWORK

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of $170.00 is attached (please note that the previously paid amount of $330.00 paid in connection with the July 12, 2004 Appeal Brief, should be applied to the total fee). The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

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Date: February 9, 2006

Attorney Docket No.: Q62357

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
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Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Alcatel. Assignment of the application was submitted in U.S. Patent and Trademark Office on December 19, 2000, and recorded on the same date at Reel 011384, Frame 0848.

II. RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-14 are all of the claims pending in the application. Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fleming, III (U.S. Patent No. 6,697,484; hereinafter "Fleming") in view of DeFazio et al. (U.S. Patent No. 5,940,484; hereinafter "DeFazio"). All of the claims are set forth in the attached Appendix.

IV. STATUS OF AMENDMENTS

In response to the objection to claims 1 and 7 in the Office Action dated May 9, 2005, Appellant amended claims 1 and 7 in the September 9, 2005 Amendment as suggested by the Examiner to address grammatical informalities. However, the Advisory Action dated October 17, 2005 indicates that the Amendment filed September 9, 2005 will not be entered without providing any reasons for denying entry of the amendments to claims 1 and 7.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention is directed to a method and terminal for obtaining information regarding the identity of a caller for incoming calls. (page 1, lines 4-6). As shown in the Figure, a terminal 10 (e.g., a mobile station of a mobile public network) comprises an agent 14 including a program or an application which is stored and activated on the terminal. The terminal 10 is communicably linked to a radio interface 4 which is communicably linked to a public switched telephone network (PSTN) 1 and a wireless application protocol (WAP) server 6. The WAP server is connected to the radio interface 4, to the PSTN 1 and to the Internet and/or an intranet 8. (page 5, lines 21-34).

The claimed invention requires receiving at the terminal an incoming call from a caller and a telephone number of the caller, and the agent of the terminal, selecting from among a plurality of external servers at least one external server likely to be able to provide information regarding the identity of the caller. (page 5, line 35 - page 6, line 29 and page 7, lines 12-28). The claimed invention further requires preparing at the agent of the terminal a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller, and sending from the agent of the terminal the request to the server. (page 6, line 19 - page 7, line 27).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Rejection of claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Fleming, in view of DeFazio.

VII. ARGUMENT

Appellant respectfully submits that independent claims 1-14 would not have been rendered obvious in view of the combination of Fleming and DeFazio because the combined references do teach or suggest all of the features of the claimed invention.

Claim 1 recites:

> receiving at the terminal an incoming call from a caller and a telephone number of the caller;
>
> at the agent of the terminal, selecting from among a plurality of external servers at least one external server likely to be able to provide the information regarding the identity of the caller;
>
> preparing at the agent of the terminal a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller; and
>
> sending from the agent of the terminal the request to the server.

Claim 7 is directed to a terminal of a telephone communications network and recites limitations similar to those in claim 1 except in apparatus format.

The Examiner concedes that Fleming does not teach or suggest "at the agent of the terminal, selecting from among a plurality of external servers at least one external server likely to be able to provide information regarding the identity of the caller", as recited by claim 1 and similarly recited in claim 7. In view of this deficiency of Fleming, the Examiner asserts that "DeFazio discloses caller identification services providing a number of databases (external servers), as one of the databases may not contain the needed information [col. 7: lines 17-26]." The Examiner further asserts that "it would have been obvious to ... modify Fleming to include

DeFazio .. [in order] to provide a selection of external servers in case one server cannot fulfill the request to identify the caller."[1]

However, Appellant respectfully submits that even if one of ordinary skill in the art would have been motivated to modify the method and/or system of Fleming based on the teachings of DeFazio, the resulting method and/or system would not select at the agent of the terminal, at least one external server likely to be able to provide the information regarding the identity of the caller from among a plurality of external servers, as required by the claims.

Fleming discloses a method and a telephone system wherein a cellular telephone 30 detects an incoming telephone call and determines if the telephone number of the call's originator has previously been stored in a memory 38 of the telephone 30. If the originator's telephone number has not been previously stored, it is stored into the memory 38 of the telephone. In addition, if an alphanumeric identifier associated with the originator's telephone number was received with the originator's telephone number, it is also stored into memory 38. If the alphanumeric identifier was not received, the telephone 30 automatically initiates a call to a remote computer 12 and transmits the telephone number of the originator to the remote computer 12 which includes a database of telephone numbers and alphanumeric identifiers which have been assigned to each telephone number. The computer 12 assigns an alphanumeric identifier to the telephone number and transmits the alphanumeric identifier back to the telephone 30 which stores the alphanumeric identifier in the memory 38 in association with the telephone number. See column 3, line 28 – column 5, line 55 and Figs. 1-3 of Fleming.

[1] May 9, 2005 Office Action at page 3.

DeFazio discloses a self-provisioning names database which adds new names to a database for associating names to calling address data in a caller identification with name delivery service each time a new caller places a call to a service subscriber. As shown in Figure 1, a calling party 1 places a call through the public switched telephone network 2 and is ultimately connected to a local switch 3 serving a called subscriber 4 having a telephone and an associated caller identification display unit 4a. A names database 5 is communicably linked to the local switch 3. A national or other names database 6 is communicably linked to the names database 5. When the calling party 1 initiates a call to the called subscriber 4, the local switch (or private branch exchange switch) requests the names database to provide a name associated with the telephone number of the calling party 1. The database 5 queries itself, and if no name is found, initiates a further query or queries to a national database 6 and/or other databases. If a name is found in the database 5 or the national database 6, the name is provided to the called subscriber 4 when the call is connected to the called subscriber 4. See DeFazio at col. 3, line 27 - col. 4, line 4.

As conceded by the Examiner in the January 8, 2004 Office Action (page 2, last paragraph), DeFazio does not disclose "the agent resides in the terminal and includes a program or an application that is stored and activated on the terminal." Rather, DeFazio simply discloses that when the local switch of the telephone network receives a call to the called subscriber, the local switch requests a predetermined (first) database to provide a name of the calling party. If the first database is unable to provide a name of the calling party, the first database sends one or more requests to other databases to provide a name of the calling party.

Similarly, the portion of DeFazio cited by the Examiner in support of the rejection (i.e., col. 7, lines 17-26), indicates that if a TCP/IP query, by an SS7 network (K) linked to the local switch

(3), of more than one database comes up empty, a back-up list of databases may be contacted (by the local switch or the SS7 network) using a query other than a TCP/IP query, e.g., a dial up connection.

Thus, nowhere does DeFazio teach or suggest that a terminal selects from among a plurality of external servers at least one external server likely to be able to provide information regarding the identity of the caller. Instead, the local switch and/or the SS7 network generates queries which are transmitted to one or more databases.

Accordingly, any modification of the method and/or system of Fleming based on the teachings of DeFazio would simply result in the remote computer 12 or mobile telephone switching office 14 (not the telephone/terminal 30) sending a request or requests to other databases if the remote computer 12 if the remote computer 12 is unable to assign an alphanumeric identifier (name) to the telephone number of the calling party.

In the October 17, 2005 Advisory Action, the Examiner asserts that "Fleming teaches that the agent of the terminal selects an external server likely to be able to provide information regarding the identity of the caller." However, in Fleming, the controller of cellular telephone does not "select" an external server likely to be able to provide information regarding the identity of the caller.[2] Instead, Fleming's cellular telephone simply places a call to a predetermined remote computer without performing any operation which involves a selection or choice.[3]

[2] The verb "select" is defined by Merriam-Webster's Collegiate Dictionary (10th Edition) as meaning "chosen from a number or group by fitness or preference".

[3] See column 5, lines 12-27 of Fleming.

Further, in claim 1, the selection step ("selecting from ...") precedes the sending step ("sending from ...") and even the preparation step ("preparing at ..."). DeFazio does not make any selection step before preparing and sending its request. O*n the contrary*, referring to the passage cited by Examiner (column 7 lines 17-26), further selection of another database is performed after preparing and sending a first request to first database 6 because this further selection *only* happens when first "a first database 6 *fails* to provide a Name for a calling party" (see DeFazio column 7, line 17).

Accordingly, another difference between the invention of claim 1 and the Examiner's proposed combination of Fleming and DeFazio is that in the combined references, the selection step will always happen after the failure of a first request to a first database, never before. This difference is noted in the present application at page 5, second full paragraph: "to begin by determining a server likely to be able to provide the required information, as a preliminary step before retrieving the information".

In view of the above, Appellant respectfully submits that even when the claims are given their broadest possible interpretation, the applied references, alone or in combination, do not teach or suggest the unobvious features recited in claims 1-14. Therefore, Appellant respectfully submits that the rejection of the claims should be reversed and the claims passed to issue.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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CLAIMS APPENDIX

CLAIMS 1-14 ON APPEAL:

1. (Previously Presented) A method of obtaining information regarding an identity of a caller in a terminal of a telephone communications network, wherein the terminal comprises an agent including a program or an application which is stored and activated on the terminal, the method comprising:

receiving at the terminal an incoming call from a caller and a telephone number of the caller;

at the agent of the terminal, selecting from among a plurality of external servers at least one external server likely to be able to provide the information regarding the identity of the caller;

preparing at the agent of the terminal a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller; and

sending from the agent of the terminal the request to the server.

2. (Previously Presented) The method of claim 1, further comprising:

receiving at the agent of the terminal a response to the request from the server; or

if a response to the request is not received at the agent, or if the response is not satisfactory, selecting at the agent another server likely to be able to provide said information on the identity of the caller, preparing at the agent another request indicating the telephone number of the caller and requesting the information regarding the identity of the caller, and sending from the agent the other request to the other server.

3. (Previously Presented) The method of claim 2, wherein the steps of receiving the response or selecting another server, preparing another request, and sending the other request to the other server are repeated if the response to the other request is not received at the agent or if the response to the other request is not satisfactory.

4. (Previously Presented) The method of claim 1, wherein the step of selecting at the agent at least one external server likely to be able to provide said information on the identity of the caller is performed by searching a request file.

5. (Previously Presented) The method of claim 1, wherein the terminal has a data channel and wherein the request is sent on the data channel.

6. (Original) The method of claim 1, wherein the terminal is a mobile terminal.

7. (Previously Presented) A terminal of a telephone communications network in which a telephone number of a caller is transmitted to the terminal at the time of an incoming call to the terminal, the terminal comprising an agent for configured to select from among a plurality of external servers at least one external server likely to be able to provide information regarding an identity of a caller, prepare a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller, and send the request from the terminal to the server, wherein the agent comprises a program or an application which is stored and activated on the terminal.

8. (Previously Presented) The terminal of claim 7, wherein the agent is configured to receive a response to the request from the server, and if there is the response is not received, or if the response is not satisfactory, select another server likely to be able to provide said information on the identity of the caller, prepare another request indicating the telephone number of the caller

and requesting the information regarding the identity of the caller, and send the other request to the other server.

9. (Previously Presented) The terminal of claim 8, wherein the agent is configured to select another server, prepare an additional request, and sending the additional request to the other server if there is no response to the other request or if the response to the other request is not satisfactory.

10. (Previously Presented) The terminal of claim 7, wherein the agent is configured to access a request file to select the server and prepare the request.

11. (Previously Presented) The terminal according to claim 7, wherein the terminal has a data channel and wherein the request is sent on the data channel.

12. (Original) The terminal according to claim 7, wherein the terminal is a mobile terminal.

13. (Original) The terminal of claim 7, wherein the terminal is a fixed terminal connected to the telephone network.

14. (Original) The terminal of claim 7, wherein the terminal is a fixed terminal having access to the Internet.

EVIDENCE APPENDIX:

There has been no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other similar evidence.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.